

REMARKS

In the Final Office Action¹, the Examiner:

rejected claims 1-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite;

rejected claims 1-8, 10, 11, 13-18, 20, 21, and 23-32 under 35 U.S.C. § 102(b) as allegedly anticipated by *B2B Collaborative Commerce with Sametime, QuickPlace and WebSphere Commerce Suite* authored by Nielsen ("Nielsen");

rejected claims 9, 19, and 22 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen in view of a web page news release entitled *United Nations and Oasis Join Forces to Produce Global XML Framework for Electronic Business* published by ebXML ("ebXML"); and

rejected claim 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen in view of Official Notice.

Claims 1, 21, 23, and 25 have been amended. No new matter is added by this amendment. Claims 1-32 remain pending.

The Advisory Action did not discuss or explicitly withdraw the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph. Notwithstanding, however, Applicant asserts that the rejection is improper because claims 1-20 are definite. Should the Examiner disagree, Applicant respectfully requests that the Examiner provide a citation to the M.P.E.P. to show that claim 1 is indefinite for reciting a "[a] computer-readable storage medium comprising instructions, which when executed on a processor cause the processor to perform a method."

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

With respect to the dependent claims, the M.P.E.P., in § 608.01(n), states

“[t]he fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.”

Applicant asserts that the rejection of claims 2-20 is improper under §608.01(n) of the M.P.E.P. because these claims are proper whether they recite further elements of the claimed “computer-readable storage medium” or further characterize the claimed “computer-readable storage medium.” Applicant submits that each of the dependent claims further define patentable features of the claimed “computer-readable storage medium” or further characterize the medium’s performance of a “method.” Accordingly, claims 1-20 are definite and the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Applicant respectfully traverses the rejection to claims 1-8, 10, 11, 13-18, 20, 21, and 23-32 under 35 U.S.C. § 102(b). In order to properly establish that Nielsen anticipates Applicant’s claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Nielsen does not anticipate the claims at least because it fails to teach, or even suggest, each and every element of the claims.

Claim 1 recites, among other features, “defining a sequence of business transactions to be executed” and “creating a business schema by assigning a document

to each business transaction in the sequence of business transactions.” Nielsen does not disclose, or even suggest, at least these features of claim 1.

Even under the broadest reasonable interpretation of Nielsen, there is nothing that discloses or even suggests the claimed “predefining a sequence of business transactions to be executed.” Nielsen discloses that a customer can “purchase goods” if he is “authorized,” he can “browse the catalog,” he can “create requisition lists,” he can “issue an order,” and he can “see the status for current orders.” Nielsen p. 17-18. But, even if Nielsen executes each of these abilities during a purchase, there is no disclosure, or even suggestion, that a “sequence of business transactions” is “predefined.” For example, Nielsen does not disclose or suggest that “purchasing goods” must occur before a customer “browse[s] the catalog” or “create[s a] requisition list.” In other words, Nielsen does not explicitly define a “sequence of business transactions.” Thus, claim 1 is allowable at least because Nielsen does not disclose or suggest at least this element of claim 1.

Notwithstanding the above, claim 1 is also allowable because Nielsen does not disclose or suggest the claimed “creating a business schema by assigning a document to each business transaction in the sequence of business transactions.”

The Advisory Action suggests that in Nielsen, a “user or buyer creates a requisition list based on the products from the catalog. And (page 26) Figure 11 . . . illustrates requisition lists (e.g., a document) of a buyer in order to perform a business transaction (e.g., issue an order or reorder).” Advisory Action p. 2. Inasmuch as the Advisory Action suggests that this discloses the claimed “creating a business schema

by assigning a document to each business transaction in the sequence of business transactions,” the Advisory Action is incorrect.

Nielsen does not disclose or suggest that a document is assigned to “each business transaction in the sequence of business transactions” as claimed in claim 1 (emphasis added). Even if it is asserted that Nielsen discloses a “sequence” of transactions, which is not correct for the reasons outlined above, it cannot be said that Nielsen assigns a document to each distinct “business transaction” in the “sequence of business transactions.” For example, even if a “requisition list” in Nielsen could constitute a “document,” which Applicant does not concede, there is no disclosure that a “document” is assigned to “each business transaction in the sequence of business transactions.” Thus, claim 1 is allowable because Nielsen also does not disclose or suggest at least this feature of claim 1.

Independent claims 21, 23, and 25, while of different scope, recite elements similar to those of claim 1 and are thus allowable over the references for at least the reasons similar to those discussed above in regard to claim 1. Dependent claims 2-8, 10-11, 13-18, 20, 23-24, and 26-32 are allowable at least due to their dependence on one of claims 1, 21, 23, or 25. Applicant therefore request that the rejection of claims 1-8, 10-11, 13-18, 20-21, and 23-32 be withdrawn.

Applicant respectfully traverses the rejection of claims 9, 12, 19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of either ebXML or Official Notice.

Claims 9, 12, 19, and 22 depend from independent claims 1 or 21 and thus include all elements of claim 1 or 21. As discussed above, Nielsen does not teach,

suggest, or render obvious each and every element recited in claims 1 and 21. Neither ebXML nor Official Notice remedy the deficiencies of Nielsen. Claims 9, 12, 19, and 22 are therefore also allowable for reasons at least similar to those presented above for claim 1. Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 9, 12, 19, and 22.

With regard to claim 12, Applicant respectfully traverses the rejection of claim 12 under 35 U.S.C. § 103(a) in view of Official Notice. The Final Office Action has misstated the law with respect to Official Notice. There is no requirement that Applicant, in order to properly challenge Official Notice, provide “adequate information or arguments so that on its face it creates a ‘reasonable doubt’ regarding the circumstances justifying the Official Notice” (internal quotes added). Advisory Action p. 2. Reasonable doubt is not the evidentiary burden applied to patent prosecution.

Furthermore, the M.P.E.P., in section 2144.03(A), states

“[i]t is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”)

Applicant asserts that the Final Office Action which states “it is old and well known in information system and software developing environment[s] and to one of ordinary skill in the art to use a selection mask” is improper because it relies solely on “common knowledge” in the art without evidentiary support in the record as evidence. Thus, Applicant respectfully requests that documentary evidence be provided with respect to the assertion of Official Notice.

Absent a showing of documentary evidence, the Office Action has failed to make a *prima facie* case of obviousness regarding dependent claim 12. Accordingly, the rejection of claim 12 should be withdrawn for this additional reason.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Travis R. Banta
Reg. No. 60,498
(202) 408-4000